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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/422,758 10/21/99 PACKHAM

C 11223/002001

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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3724

DATE MAILED:

07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/422,758

Applicant(s)

PACKHAM ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,40,41,44,45,48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,38,39,42,43,46,47 and 50-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 4/25/01 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed on April 25, 2001 has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 25, 2001 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the features in the proposed amendment to Fig. 3.

Election/Restrictions

3. Applicant's election without traverse of Group I, Species I, claims 1-19, 38, 39, 42, 43, 46, 47, and 50-53, in Paper No. 8 is acknowledged.
4. Claims 20, 21, 40, 41, 44, 45, 48, and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups and Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Information Disclosure Statement

5. Receipt is acknowledged of the IDS filed on April 25, 2001. It is noted that some of the references have been crossed out due to duplication.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "118" has been used to designate both a parabolic end skirt (Fig. 1)

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and an under cutter (Fig. 11); "243" has been used to designate both a cutaway of a mask (Fig. 26) and a foil aperture pattern (Fig. 27); "41" has been used to designate both a curved under cutter (Fig. 4) and a developer (Fig. 32); "42" has been used to designate by a drive arrangement (Fig. 4) and something that appears to be a stirrer (Fig. 32).

Correction is required.

7. The drawings are objected to because in Fig. 18, reference "61" should read -- 161 --. Correction is required.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate hair-capture slots (e.g. claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "121" (amendment to p. 9, l. 10); "181" (amendment to p. 10, l. 32); "244" (amendment to p. 23, l. 1). Correction is required.

Claim Objections

10. Claim 1 is objected to because of the following informalities: "region" should read -- region --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. Claim 9 is vague and indefinite in that it is not clear what the claim encompasses. Where is the “elongate hair-capture slots” shown in the drawings? **The same applies to the rest of the claims.**

Claim Rejections - 35 USC § 102

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1-17 and 50-54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pranjko (DE M9004739.7). See Fig. 1.

Claim Rejections - 35 USC § 103

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 18, 19, 38, 39, 42, 43, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7) in view of Packham (GB 2,036,631 A).

Pranjko discloses the invention substantially as claimed including an inherent under cutter that is oscillatory driven by a driving element due to the fact that the shaving system of Pranjko is an electric shaver with a curved skin engaging surface and for the shaving system of Pranjko to operate as intended, it must have an under cutter that conforms to the outer cutter and oscillates in correspondence with the curved surface of the outer cutter. See whole document. However, if it is argued that Pranjko lacks the under cutter and drive element, then Packham clearly teaches a shaving system comprising a curved outer surface 8 which functions as an outer cutter, an under cutter 9 conforming to the outer cutter, and a drive element 4 that oscillates the under cutter for the purpose of providing the positive cutting action for drive shaver systems. See Fig. 2, p. 1, ll. 93-125. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the under cutter and drive element as taught by Packham in order to facilitate positive cutting action of the dry shaver.

18. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7).

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Pranjko discloses the invention substantially as claimed including what appears to be same material curved regions and end cheek regions. However, if it is argued that Pranjko lacks this feature, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the same material regions in order to facilitate ease of manufacture due to the same material being used to produce the same, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

19. Applicant's arguments filed April 25, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Pranjko does not anticipate the claimed invention because it is allegedly a design patent with no written description,¹ this argument lacks merit. It is irrelevant whether or not there is a written description with respect to the drawings shown in Pranjko, since these drawings clearly show the structure being claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Moreover, Applicant's allegation that Pranjko is not a valid anticipatory reference because Pranjko was not in the hands of the public is confusing. The fact that the reference is a published reference is a *prima facie* showing that the reference was in the hands of the public at the time of the instant invention. It is not clear what point Applicant is trying to make here.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

¹ See Amendment B, Paper No. 13, p. 6, l. 16 - p. 7, l. 8.


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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg
July 16, 2001

Charles Goodman
Patent Examiner
AU 3724


BOYER ASHLEY
PRIMARY EXAMINER